

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte CHRIS W. MAHNE, STEVE ZIZZI, SHANNON VON BURNS,  
and KEN TOWNSLEY

Appeal No. 2004-1940  
Application No. 09/259,991

ON BRIEF

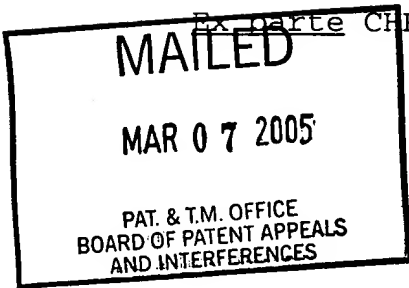
Before RUGGIERO, BLANKENSHIP, and SAADAT, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the Examiner's rejection of claims 59, 68-73, 75, 76, 78, and 79. Claims 1-46 have been canceled, and claims 47-58, 60-67, 74, 77, and 80 have been allowed. An amendment filed July 7, 2003 after final rejection was approved for entry by the Examiner.

The claimed invention relates to the encryption and decryption of files using a selected one of a plurality of encryption algorithms. During the file encryption process, an



encryption algorithm and an encryption key with a key value are selected. A file identifier, which is generated from the encryption key, an algorithm identifier associated with the selected algorithm, and a data identifier associated with the file, is added to the file to be encrypted. The file is then encrypted using the key value and the selected algorithm. To begin the implementation of the decryption process, a user inputs a decryption key with a decryption key value. After the decryption key is validated with the key value associated with the file identifier, the key value and the selected algorithm are used to decrypt the encrypted file.

Claim 59 is illustrative of the invention and reads as follows:

59. A method of decrypting an electronic file that is to be opened in an application program running in a suitable environment for operating the program, comprising the steps of:

- a) issuing an open document command to act upon the file;
- b) intercepting the open document command;
- c) retrieving a decryption key value;
- d) decrypting the file using the decryption key value to create an unencrypted file; and

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e) completing the open document command by performing the open document command upon the unencrypted file instead of the file; and

wherein steps c) and d) further comprise the steps of:

selecting an algorithm to use with the file from one of a plurality of algorithms;

inputting a decryption key with a key value;

validating the decryption key value with the key value associated with a file identifier;

using the key value and the selected algorithm to decrypt the file; and

running a virus scan program on the decrypted file.

The Examiner relies on the following prior art:

Hsu	5,584,023	Dec. 10, 1996
Finley	5,815,571	Sep. 29, 1998
Brundrett et al. (Brundrett)	US 6,249,866 B1	Jun. 19, 2001
		(filed Sep. 16, 1997)

Claims 59, 68-73, 75, 76, 78, and 79, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Hsu in view of Brundrett with respect to claims 68-73, 76, 78, and 79, and adds Finley to the basic combination with respect to claims 59 and 75.

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Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs<sup>1</sup> and Answer for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection, and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 59, 68-73, 75, 76, 78, and 79. Accordingly, we affirm.

Appellants' arguments in response to the Examiner's rejection of the appealed claims are organized according to a

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<sup>1</sup> The Appeal Brief was filed November 12, 2003 (Paper No. 29). In response to the Examiner's Answer dated January 28, 2004 (Paper No. 30), a Reply Brief was filed February 5, 2004 (Paper No. 31), which was acknowledged and entered by the Examiner as indicated in the communication dated April 7, 2004 (Paper No. 32).

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suggested grouping of claims indicated at page 5 of the Brief. We will consider the appealed claims separately only to the extent separate arguments for patentability are presented. Any dependent claim not separately argued will stand or fall with its base claim. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed waived (see 37 CFR § 41.37(c)(1)(vii)).

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re

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Hedges, 783 F.2d 1038, 1039-40, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

With respect to independent claim 68, the representative claim for Appellants' first suggested grouping (including claims 68-73, and 79), Appellants' arguments in response to the Examiner's 35 U.S.C. § 103(a) rejection assert a failure to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. After reviewing the applied Hsu and Brundrett references in light of the arguments of record, we are in general agreement with the Examiner's position as stated in the Answer.

Appellants' arguments (Brief, page 7) highlight the language of claim 68 which requires the inputting of a decryption key with a decryption key value and the validation of the decryption key value with the key value associated with a file identifier. We find no error, however, in the Examiners' assertion (Answer, page 4) of correspondence between the disclosure of Hsu and Appellants' argued claim limitations. In our view, the enode structure described by Hsu can reasonably be interpreted as

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corresponding to the claimed file identifier. Further, as asserted by the Examiner, Hsu, at column 14, lines 15-67, discloses that an inputted decryption key value is validated against the key value associated with the enode structure, i.e., the file identifier.

Further, we find no basis for Appellants' assertion (Reply Brief, page 3) that validation in Hsu takes place with a user entered password key which is not the decryption key recited in the appealed claims. It is apparent to us from our review of Hsu that, while a user may initiate the encryption process with an entered password key, this password key is subsequently encrypted using a seed table and a shuffle function (Hsu, column 11, line 45 et seq.) to develop an encryption table which the Examiner, correctly in our view, likens to an encryption key. This encryption table in turn is utilized to generate a decryption table which is used as a decryption key in the validation process described at column 14, lines 15-67 of Hsu. We also find nothing in the language of representative claim 68 which precludes user involvement through entry of a password key.

For the above reasons, since it is our opinion that the Examiner's prima facie case of obviousness has not been overcome by any convincing arguments from Appellants, the Examiner's

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35 U.S.C. § 103(a) rejection of representative claim 68, as well as claims 69-73 and 79 which fall with claim 68, is sustained.

Turning to a consideration of the Examiner's obviousness rejection of claims 76 and 78, grouped and argued together by Appellants, we sustain this rejection as well. In their arguments (Brief, page 9) asserting a failure of the Hsu and Brundrett references to disclose the claimed invention, Appellants highlight the claim language which sets forth the encryption feature of generating a file identifier from an encryption key, an associated algorithm identifier, and a file associated data identifier. We find no error, however, in the Examiner's position as articulated at pages 4 and 5 of the Answer. As asserted by the Examiner, the file identifier or enode data structure in Hsu is developed from an encryption key (encryption table) using a seed table associated with a particular encryption algorithm, the file identifier structure having data identifiers which are part of the encryption table and which are arithmetically associated with a decryption table or decryption key (Hsu, column 11, line 45 through column 12, line 67).



We also make the observation that it is a basic tenet of patent law that claims are to be given their broadest reasonable interpretation consistent with the description in the specification. With this in mind, we have reviewed Appellants' specification for guidance as to the proper interpretation of the claim language setting forth the file identifier generation feature and we find little enlightenment as to how to properly interpret such claim language. Further adding to this difficulty is the fact that Appellants' arguments in the Briefs do not refer to any specific portion of their specification, nor do we find in the specification or drawings any detailed description of the file identifier generation process or any details of the resulting data structure. Given the paucity of description in Appellants' disclosure, we can only reach the general conclusion that the language of claims 76 and 78 simply does not require the interpretation asserted by Appellants in the Briefs.

We also find to be unpersuasive Appellants' arguments (Brief, pages 10-13; Reply Brief, page 4) that the Examiner's proposed combination of Hsu and Brundrett would destroy the intended function of Brundrett. In our view, Appellants' arguments to the contrary notwithstanding, it is apparent from the line of reasoning expressed in the Answer that the Examiner

is not suggesting the bodily incorporation of the encryption/decryption features of Brundrett into the system of Hsu. Rather, it is Brundrett's teaching of selecting from among a plurality of encryption algorithms (Brundrett, column 10, lines 53-67) that is relied on as a rationale for the proposed combination. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . . . Rather, the test is what the combined teachings of [those] references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). See also In re Sneed, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) and In re Nievelt, 482 F.2d 965, 967-68, 179 USPQ 224, 226 (CCPA 1973).

Lastly, we also sustain the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 59 and 75 in which the Finley reference was added to the combination of Hsu and Brundrett to address the virus scan feature of these claims. Appellants' arguments in response to this rejection rely solely on arguments made with respect to claims 68-73, 76, 78, and 79, which arguments we found to be unpersuasive for all of the reasons discussed supra.

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In summary, we have sustained the Examiner's 35 U.S.C. § 103(a) rejection of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 59, 68-73, 75, 76, 78, and 79 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. and TM Office 21 (September 7, 2004)).

AFFIRMED



JOSEPH F. RUGGIERO )  
Administrative Patent Judge )



HOWARD B. BLANKENSHIP )  
Administrative Patent Judge )



MAHSHID D. SAADAT )  
Administrative Patent Judge )

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